

PATENT

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*11/19/03*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number : 09/599,602 Confirmation No.: 1459  
Applicant : Robert J. Rosko  
Filed : June 23, 2000  
Title : System and Method for Implementing a Consolidated Application Process  
TC/Art Unit : 3624  
Examiner: : Geoffrey R. Akers

Docket No. : 47004.000073  
Customer No. : 21967

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**APPEAL BRIEF**

Sir:

In accordance with 37 C.F.R. § 1.192, applicant submits this appeal brief in the above captioned application. Applicant appeals the final rejection of claims 1-19 set forth in the Office action mailed July 2, 2003 (hereinafter final Office action). A Notice of Appeal was filed in accordance with 37 C.F.R. § 1.191 on October 2, 2003. This submission is filed within the two months of the filing of the Notice of Appeal. Attached hereto is a check for \$330.00 covering the fee set forth in 37 C.F.R. § 1.17(c). Any additional fees that may be due but are not attached may be charged to Deposit Account No. 50-0206.

Real Party in Interest

The real party in interest is Bank One Corporation having a place of business at Bank One Plaza, Chicago, Illinois.

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### Related Appeals and Interferences

To best of appellant's knowledge, there are no related appeals or interferences.

### Status of Claims

Claims 1-19 are pending and stand rejected. The rejections of claims 1-19 are appealed.

### Status of Amendments

No amendments to the claims have been entered or proposed subsequent to the final rejection.

### Summary of Invention

The present invention provides a consolidated application system that comprises a dynamic application module. Users choose one or more services provided through a networked service provider. Then, the dynamic application module presents the customer with a consolidated application, which is partially completed with information that is known about the customer. After the customer completes the blank portions of the application, the dynamic application module sends the application to another server for real-time processing.

Applicant's invention, as defined by the pending claims, is a method or system for providing a dynamically created application form through a network to a consumer applicant for one or more products. The invention is directed particularly to tailoring an application form to a particular request from an applicant. Thus, an applicant may apply for multiple requested products, such as banking products, by completing one application form tailored to the applicant's request. As an example, a potential applicant may chose from an array of products offered by a product provider, such as a bank. The potential applicant may request to apply for a checking account and a credit card account. The instant invention then dynamically creates an application form to solicit the information required to apply for both a checking account and a credit card. In this manner, the applicant provides the required information to the bank in one convenient action.

## Issues

The issue on appeal is generally whether the applied references directed to general computer architecture and Internet functions render obvious the pending claims specifically related to application forms. Specifically, the issue is whether claims 1-19 are patentable over U.S. Patent 6,438,594 in view of U.S. Patent 6,298,356 as applied under 35 U.S.C § 103(a) in the final Office action.

## Grouping of Claims

The final Office action applies broad references that fail to show or suggest the specific limitations set forth in most of the pending claims. Accordingly, although an analysis of individual claims should contain many similarities, the individual claims include limitations absent from the applied art that differentiate the claims from each other. Claims 1, 8, and 14 are independent claims. Claims 2-7 depend from claim 1. Each of claims 2-7 set forth additional limitations that are not suggested by the applied art. Accordingly, each of claims 2-7 stands on its own with respect to claim 1. Claim 8 is an independent claim with limitations, absent from the applied art, that differentiate claim 8 from claim 1. Claims 9-13 depend from claim 8. Claims 9 and 12 set forth additional limitations that are not suggested by the applied art. For the purposes of this appeal, claims 10 and 11 stand or fall with claim 9. For the purposes of this appeal, claim 13 stands or falls with claim 8. Claim 14 is similar to claim 1 and includes additional limitations related to the limitations set forth in dependent claim 7. Accordingly, for the purposes of this appeal, claims 7 and 14 stand or fall together. Claims 2-6 are identical to claims 15-19 with exception that claims 15-19 depend from claim 14 rather than claim 1. Accordingly, should the rejection of claim 14 be upheld, claims 15-19 will stand or fall for reasons identical to claims 2-6 respectively.

## Argument

### Brief History of the Prosecution of the Application

This application was filed June 23, 2000. A preliminary amendment was filed December 19, 2000. An initial Office action was mailed August 27, 2002, in which the claims were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,438,594 issued to

Michel K. Bowman-Amuah (Bowman-Amuah) in view of U.S. Patent 6,298,356 issued to Janardhanan Jawhar and Venkatachari Dilip (Jawahar). On November 27, 2002, applicant filed a response setting forth reasons why these applied references are insufficient to render the pending claims obvious. The claims were not amended. A second non-final Office action was mailed January 31, 2003, in which deficiencies of the Bowman-Amuah and Jawahar were recognized. The 2003 non-final Office action rejected the claims under 35 U.S.C. § 103(a) as being unpatentable over Bowman-Amuah in view of Jawahar in view of U.S. Patent 6,493,677 issued to Ernest J. A. von Rosen and Vaclav Vincalek (von Rosen) and further in view of U.S. Patent 6,202,054 issued to Mathew P. Lawlor and Timothy E Carnody. On April 30, 2003, applicant filed a response setting forth reasons why these four references are insufficient to render the pending claims obvious. Again the claims were not amended. The final Office action was then mailed on July 2, 2003. The final Office action rejects the claims for identical reasons to those presented in the initial Office action. The final Office action includes an initial three paragraphs that refer to applicant's April 30 response. The following 14 numbered paragraphs under the heading "Claim Rejections - 35 USC § 103" are practically word for word identical to the initial Office action. A brief paragraph under the heading "Response to Arguments" asserts that applicant's arguments filed April 30 have been fully considered. This paragraph also refers to von Rosen, which is not applied in the rejections.

Applicant's representative and the Examiner held a telephonic conversation August 11, 2003. In that conversation the Examiner confirmed that he had returned to a rejection based on only the Bowman-Amuah and Jawahar references and stated that the reference to von Rosen in the Response to Arguments is not a part of the outstanding rejection. Applicant appreciates the Examiner's helpful suggestions regarding possible amendments to the claims. However, as the rejections in the final Office action fail to establish a *prima facie* case of obviousness against the claims as pending, applicants appeal the outstanding rejection over Bowman-Amuah and Jawahar.

#### Requirements for Patentability

The final Office action fails to establish a *prima facie* case of obviousness that the pending claims are unpatentable over Bowman-Amuah in view of Jawahar. "During patent examination the PTO bears the initial burden of presenting a *prima facie* case of

unpatentability.” *In re Glaug*, 283 F.3d 1135, 62 U.S.P.Q.2d 1151, 1152 (Fed. Cir. 2002). “If the PTO fails to meet this burden, then the applicant is entitled to the patent.” *Id.* “To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Int. 1985). The two references applied in the final Office action fail to suggest the claimed invention for at least the reasons set forth with regard to each claim below. An artisan of ordinary skill would not have found the claimed invention to have been obvious in light of the teaching of the two applied references. As the Examiner has not presented a *prima facie* case of unpatentability, applicant is entitled to a patent.

“The ‘prima facie case’ notion . . . seemingly was intended to leave no doubt among examiners that they must state clearly and specifically any objections (the prima facie case) to patentability, and give the applicant fair opportunity to meet those objections with evidence and argument.” *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443, 1447 (Fed. Cir. 1992)(Plager, J., concurring). The final Office action makes no attempt to explain the relevance of any teachings of the applied references with regard to the claimed invention. Rather, the rejection merely states that the references teach certain described elements of the claimed invention and supports these statements with citations to the applied references, frequently to the figures of the reference. “The pertinence of each reference, if not apparent, must be clearly explained.” 37 C.F.R. § 1.104(c)(2). The mere citations to the applied references do not present a convincing line of reasoning as to why an artisan would have found the claimed invention to have been obvious in light of the teachings of the applied references.

“Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it.” M.P.E.P. § 707.07(f) (8<sup>th</sup> Ed. 2001). As applicant has traversed the outstanding rejections in the 2002 response by showing that the two applied references do not show or suggest specific limitations of the claimed invention, the Examiner should answer the substance of applicant’s argument. To the contrary, the Examiner has reverted to the initial rejection without addressing applicant’s arguments as to why the applied references fail to show or suggest the claimed invention. Accordingly, the outstanding rejection over Bowman-Amuah and Jawahar is improper.

Applicant herein reiterates the reasons why the applied references to Bowman-Amuah and Jawahar fail to show or suggest the claimed invention. Applicant sets forth in further detail below specific reasons why the final Office action fails to establish a *prima facie* case of obviousness for the pending claims.

#### Applicability of the Applied References

Bowman-Amuah is directed to a system and method for delivering a plurality of services through a global computer network by use of globally addressable interfaces and locally addressable interfaces. Bowman-Amuah, col. 2, ll. 19-25. Great detail is included regarding the advantages of and methods for constructing component or object based large-scale Internet solutions for providing business services. Bowman-Amuah, cols. 10-16. However, Bowman-Amuah merely provides options and components for developing flexible computing solutions for providing any business service. Bowman-Amuah does not address the details for providing any particular service. Bowman-Amuah attempts to teach how to develop a component based Internet type business solution, rather than teaching a system or method that provides a particular service, such as accepting applications for banking products.

Jawahar is directed to methods and apparatus for enabling dynamic resource collaboration. Jawahar, col. 2, ll. 7-14. The Jawahar system provides information to a provider of web pages regarding those who access the web pages. Jawahar, col. 13, ll. 54-60. Jawahar, like Bowman-Amuah, does not address the specifics of providing any particular service through web pages. In the Jawahar system, a record of web pages viewed by a particular user is stored for reference by an agent, who may provide additional assistance to the user. Jawahar, col. 15, l. 64 - col. 16, l. 1. Certain web pages accessed by the user may be cached to determine exactly what the user accessed. Jawahar, col. 19, ll. 47-50. One use of retaining this record of a user's access is to provide further help to the user upon request. Jawahar, col. 17, ll. 33-38. Thus when appropriate, a help button may be provided to user. Jawahar, col. 15, ll. 51-55. If the user requires further assistance, upon clicking the help button, the agent may be provided with the record of information accessed by the user. Jawahar, col. 17, ll. 47-52. The agent may then provide further assistance. Jawahar, col. 17, ll. 52-55. Accordingly, when the help button is selected, the system determines the types of web pages that have been viewed by the user and

time spent viewing each type of page. Jawahar, col. 17, ll. 36-44. The system further determines the product or services associated with web pages viewed by the user. Jawahar col. 17, ll. 37-46.

Applicant's invention, as defined by the pending claims, is a method or system for providing a dynamically created application form through a network to a consumer applicant for one or more products. (Spec. p. 1, ll. 5-7.) The invention is directed particularly to tailoring an application form to a particular request from an applicant. (Spec. p. 3, ll. 7-10.) Thus an applicant may apply for multiple requested products, such as banking products, by completing one application form tailored to the applicant's request. (Spec. p. 8, l. 21 - p. 9, l. 2.) As an example, a potential applicant may chose from an array of products offered by a product provider, such as a bank. (Spec. p. 8, ll. 2-4.) The potential applicant may request to apply for a checking account and a credit card account. (Spec. p. 8, ll. 20-21.) The instant invention then dynamically creates an application form to solicit the information required to apply for both a checking account and a credit card. (Spec. p. 10, ll. 1-4.) In this manner, the applicant provides the required information to the bank in one convenient action.

"In order to rely on a reference as the basis for rejection of an applicant's invention, the reference must be either in the field of applicants endeavor or, if not, then reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992). Applicant's invention relates to allowing customers of a networked service provider to apply for a variety of networked services on one dynamically assembled consolidated application and enables them to receive real time decisioning on their application status for many products. (Spec. p. 1, ll. 5-8.) The field of applicant's invention is thus related to electronic commerce with emphasis on the finance and banking industries. Bowman-Amuah is related to software patterns, particularly to aiding a system in need of service by locating a service provider capable of delivering the required service by way of a locally addressable interface. (Bowman-Amuah, col. 1, ll. 18-22.) Bowman-Amuah is thus in the field of network management and access regulation during multiple computer data transfer and process coordination. One of ordinary skill looking to allow customers of a service provider apply for a variety of networked services on one dynamically assembled consolidated application would have no reason to look to the field of network management and access regulation during multiple computer data transfer and process coordination. One of ordinary skill in the art to which the claimed invention pertains would not

have been aware of the teachings of Bowman-Amuah. Accordingly, Bowman-Amuah cannot properly be relied upon as the basis for rejection of applicant's invention.

The applied references fail to show or suggest any system or method for applying for any product. The applied art rather is directed to the features of Internet or Web based systems with broad application to various tasks. The applied art does not address any specific task, such as receiving applications (forms used in making a request) from potential customers for selected products. Accordingly, the applied prior art fails to suggest the specific details of applicant's invention as set forth in the pending claims. The details of the features absent from the applied art are discussed further below.

### Claim 1

Claim 1 sets forth a method for dynamically creating an application form. The method includes steps of receiving a request to apply for a plurality of products, assembling an application page from a plurality of documents each of which contains a field corresponding to specific information required to apply for a product, and receiving information corresponding to each field in the application page. The instant specification describes a particular preferred embodiment of the claimed invention. In this embodiment, an Internet banking services provider receives a potential customer's request to apply for products such as a checking account and a credit card account offered by the provider. An application page is assembled and provided to the customer. The application page requests only information required to apply for both the checking account and the credit card. The customer may then complete the application through the application page provided and cause the completed application to be sent to the provider. The applied combination of references fails to show or suggest the steps set forth in claim 1.

In the final Office action in paragraph 6, it is asserted that Bowman-Amuah teaches a method for dynamically creating a network application form. This assertion is incorrect. The support provided for this assertion is a citation to Figures 3 and 7 of Bowman-Amuah. These figures do not teach dynamically creating a network application form. In the instant specification on page 4 it is stated: "That the system is described as being part of an Internet system that enables customers of an Internet banking service provider to complete applications of particular banking services, where the applications are pre-filled with customer's personal information." The term "application form" is thus used in the sense of a form that is completed



with information to apply for particular products or services. This is confirmed by the use of the term “application form” in the last line of page 10 of the instant specification.

Bowman-Amuah is silent regarding creation of an application form. Bowman-Amuah extols the virtues of using the principles of architecture in building computer software. Bowman-Amuah, col. 17 ll. 20-23. An advantage of using architecture principles is “there is something repeatable about the work: architects can create a structure, then use the components of that structure again in the future when they come across a similar situation.” Bowman-Amuah, col. 17, ll. 28-31. This advantage is that the underlying structure of the computer software is not directly related to the specific tasks to be performed. Accordingly, Bowman-Amuah refers to Technology Architecture (the underlying structure) and Application Architecture (task specific structure). *See* Bowman-Amuah, col. 24 ll. 1-5. Bowman-Amuah thus uses the term “application” to refer to task specific computer software. Figure 3 of Bowman-Amuah illustrates a standard architecture framework. In Figure 3 various underlying structures support the applications. Figure 3 includes no teaching specific to application forms. Figure 3 provides no support for the assertion that Bowman-Amuah teaches a method of creating an application form.

Bowman-Amuah classifies technology architecture structures by technology era. Bowman-Amuah, col. 24 ll. 8-13. Columns 25-32 of Bowman-Amuah include a section titled “Technology Generation Selection,” which sets forth the strengths and weaknesses of each technology generation. Bowman-Amuah, col. 25, ll. 58-65. Figure 7 is directed to the situation in which the Netcentric technology generation should be considered. Bowman-Amuah, col. 27, ll. 7-10. Figure 7 provides no teaching specific to application forms. Figure 7 provides no support for the assertion that Bowman-Amuah teaches a method of creating an application form.

The applied art of Bowman-Amuah and Jawahar fails to show or suggest a step of receiving a request to apply for a plurality of products. In the final Office action in paragraph 6, Figure 9 of Bowman-Amuah is relied upon to suggest this step. Figure 9 is part of the “Technology Generation Selection” section of Bowman-Amuah and is directed to the situation in which the Host technology generation should be considered. Bowman-Amuah, col. 30, ll. 24-31. The final Office action refers specifically to element 902. Element 902 is the business imperatives indicating the use of the Host technology generation. Bowman-Amuah, col. 30, l. 47. None of the business imperatives shown in Figure 9 are directly related to receiving a request to

apply for a plurality of products. Claim 1 sets forth a particular consumer application for particular products provided by a business. Bowman-Amuah simply does not address a method for applying for products and thus fails to suggest a step of receiving a request to apply for a plurality of products as set forth in claim 1. Claim 1 is expressly applicable to the situation in which information is required to be submitted to apply for each one of the plurality of products. Bowman-Amuah fails to show or suggest any particular computer system that receives applications from consumers for products, such as applications for banking products. Bowman-Amuah fails to address any situation wherein specific information is required to be submitted to apply for each one of a plurality of products.

The applied art fails to show or suggest a step of assembling an application page for display over a network. In the Office action, it is acknowledged that Bowman-Amuah does not teach this step; rather the secondary reference to Jawahar is relied upon to show this step. As discussed above, Jawahar describes determining the types of web pages viewed by a user. Jawahar, col. 17, ll. 37-46. This description of Jawahar is relied upon in the Office action to show assembling an application page for display over a network. This reliance is misplaced. The information recorded by the Jawahar system is not assembled in a page for display over a network. To the contrary, this information is provided to an agent that assists the user. Jawahar col. 17, ll. 61-67. The agent is not an assembled web page, but is rather a person that communicates with the user through telephone calls, e-mail, voice mail, or facsimiles. Jawahar col. 5, ll. 10-23, col. 12, ll. 9-16. Furthermore, an application page as set forth in claim 1 refers to a page including fields corresponding to information required to apply for a product. Jawahar suggests no page associated in any manner with applying for a product. Accordingly, Jawahar cannot suggest assembling an application page as set forth in claim 1.

Jawahar cannot be properly combined with Bowman-Amuah. The Office “can satisfy [the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness] only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) There is no explanation in the final Office action regarding how any page allegedly taught by Jawahar could be combined with the Bowman-Amuah system and method for delivering a plurality of services through a global computer network by use of globally addressable interfaces and locally

addressable interfaces. There is no explanation how the Bowman-Amuah system could be modified using any teaching from Jawahar. There is no suggestion that any specific page suggested by Jawahar would have any applicability in the Bowman-Amuah system. There is no motivation to combine the teachings of Jawahar and Bowman-Amuah as suggested in the Office action. The Office action states: "The motivation to combine is to teach the search of static and dynamically generated web pages having information on them with respect to products or services (col 16 lines 59-63)being accessed by a web server with respect to information gathered and resources spent on the search of these pages as enunciated by Jawahar (col 1 line 59-col 2 line 4)." First, the applied art does not teach the search of static and dynamically generated web pages. In the Jawahar system, non-displayable information embedded in tagged web pages is logged. Jawahar col. 14, l. 56 - col. 15, l. 15. Second, there is no suggestion in the applied art that the information as logged by Jawahar would have any use in the systems of Bowman-Amuah. That Jawahar teaches gathering information on viewed web pages is not itself motivation to use such information in the system of Bowman-Amuah.

Claim 1 further sets forth that the application page is assembled from documents, wherein each document contains at least one field corresponding to information required to apply for a product. In the Office action, it is recognized that Bowman-Amuah does not teach this limitation. Jawahar is applied to show this limitation. Applicant respectfully submits that Jawahar does not show or suggest a plurality of documents wherein each document contains at least one field corresponding to the specific information required to apply for one of the plurality of products. Figures 3, 5, 6, 8, 9, and 10 of Jawahar are cited in paragraph 6 of the final Office action to support the assertion that Jawahar teaches this limitation. However, none of the figures cited in the Office action suggest any field associated with applying for any product. As discussed above, the contents of the web pages viewed by the user (specifically with regard to any product or services presented) is recorded by the Jawahar system. However, no documents are suggested that contain any field corresponding to specific information required to apply for any presented products.

Figure 3 of Jawahar illustrates a control server including video transaction manager 118, video server 94, fax server 92, e-mail server 80, e-mail transaction manager 114, fax transaction manager 116, and transaction processing system manager 120. Figure 5 is a flow diagram illustrating a procedure for communicating information between various devices. Figure 6

illustrates various windows displayed to an agent using the agent's computer. Figure 8 is a flow diagram illustrating a procedure for determining whether to display a "Help" button to a user. Figure 9 is a flow diagram illustrating a procedure for selecting an agent to provide help to a user. Figure 9 includes step 274 for determining product(s) or service(s) associated with the web pages viewed by the user. Figure 10 illustrates a table containing information relating to web pages accessed by a user. The Office action includes no explanation how any of these figures would suggest to one of ordinary skill a plurality of documents wherein each document contains at least one field corresponding to specific information required to apply for one of a plurality of products. To the contrary, Figures 9 and 10 demonstrate that each page of the Jawahar system describes aspects of a single product. There is no suggestion that any of these pages include a field corresponding to information required to apply for a product. Accordingly, Jawahar does not show or suggest a plurality of documents, each with a field corresponding to information required to apply for a product as set forth by claim 1.

The applied art also does not suggest the step of receiving information input corresponding to each field contained in the application page as set forth by claim 1. In the Office action, the Summary of the Invention of Jawahar is relied upon to show this step of receiving. However, the Summary in Jawahar includes no suggestion of receiving any information required to apply for any product. The summary merely addresses receiving requests for web pages from a user. Jawahar, col. 2, ll. 11-13. There is no suggestion that these requests include any information input that corresponds to fields of an application page as set forth by claim 1.

For at least the above reasons, Bowman-Amuah in view of Jawahar does not show or suggest the steps of the invention defined by claim 1. The bare citations to the two applied references fail to present a convincing line of reasoning as to why an artisan would have found the claimed invention to have been obvious. The final Office action fails to clearly explain the pertinence of each reference. Accordingly, the final Office action does not establish a *prima facie* case of obviousness against claim 1. Applicant, therefore, respectfully requests that this rejection of claim 1 be reversed.

## Claim 2

Claim 2 depends from claim 1 and therefore includes each step of the method of claim 1. Applicant respectfully submits that the applied references cannot properly be applied to demonstrate that the method set forth in claim 2 is obvious for at least the reasons set forth above with respect to independent claim 1. Further significant defects of the applied references as applied to claim 2 are discussed below.

Claim 2 further sets forth validating the information input, if the validation is not correct a second application page is assembled including prompts to reenter information. The secondary reference to Jawahar is relied upon to show the steps set forth in claim 2 as it is acknowledged in the final Office action that the primary reference does not teach data validation. The final Office action in paragraph 7 states that Jawahar teaches data validation and dynamically generated pages containing critical information. This statement is insufficient to demonstrate that Jawahar suggests the additional steps of claim 2. First, the mere explanation of dynamically generated pages in Jawahar is insufficient to teach the details of the presently claimed invention. The present invention includes assembling *an application page* and validating information input received that corresponds to the fields of the application page. Jawahar fails to suggest dynamic web pages that include fields corresponding to information needed *to apply* for more than one product. Second, although various citations to Jawahar are provided in the Office action, none of the cited passages address validation as set forth in claim 2. Column 18, line 28, through column 19, line 2, of Jawahar is directed to introducing dynamic web pages and the disadvantages of URL sharing. Column 6, lines 40-58, is directed to the features of an agent computer system. Column 13, lines 29-31, states that the window displayed to the agent contains various system information such as information about the agent and about system performance. Column 20, lines 34-44, indicates that web pages including an expiration date may be dynamic web pages, which should be cached. There is no suggestion in any of these citations of a validation by comparing information. There is no suggestion in any of these citations of assembling a second application page. Jawahar does not suggest comparing data received to validation criteria and assembling a second application page if the validation is not correct as set forth in claim 2. Furthermore, there is no motivation to combine the teachings of Bowman-Amuah and Jawahar for the reasons discussed above with respect to claim 1.

For at least the reasons set forth with respect to claim 1 and the further specific reasons set forth above, Bowman-Amuah in view of Jawahar does not show or suggest the steps of the invention defined by dependent claim 2. Accordingly, the final Office action does not establish a *prima facie* case of obviousness against claim 2. Applicant respectfully requests that the rejection of claim 2 over Bowman-Amuah in view of Jawahar be reversed.

### Claim 3

Claim 3 depends from claim 1 and therefore includes each step of the method of claim 1. Applicant respectfully submits that the applied references cannot properly be applied to demonstrate that the method set forth in claim 3 is obvious for at least the reasons set forth above with respect to independent claim 1. Further significant defects of the applied references as applied to claim 3 are discussed below.

Claim 3 includes the step of forwarding the information input to a decision module for processing the information input. The control server of Jawahar is relied upon to show this step. (Final Office Action ¶ 8.) However, Jawahar includes no suggestion that the control server forwards any information input corresponding to fields in an application page to a decision module. To the contrary, the control server as shown in Figure 3 includes a central control module, various transaction managers, an active script module, and a data logging and reporting module. Jawahar col. 8, l. 41 - col. 10, l. 54. There is no suggestion in Jawahar that any of these components forward any information input corresponding to fields in an application page to a decision module. Jawahar thus fails to show or suggest the step set forth in claim 3. Furthermore, there is no motivation to combine the teachings of Bowman-Amuah and Jawahar for the reasons discussed above with respect to claim 1.

For at least the reasons set forth with respect to claim 1 and the further specific reasons set forth above, Bowman-Amuah in view of Jawahar does not show or suggest the steps of the invention defined by dependent claim 3. Accordingly, the final Office action does not establish a *prima facie* case of obviousness against claim 3. Applicant respectfully requests that the rejection of claim 3 over Bowman-Amuah in view of Jawahar be reversed.

Claim 4

Claim 4 depends from claim 1 and therefore includes each step of the method of claim 1. Applicant respectfully submits that the applied references cannot properly be applied to demonstrate that the method set forth in claim 4 is obvious for at least the reasons set forth above with respect to independent claim 1. Further significant defects of the applied references as applied to claim 4 are discussed below.

Claim 4 includes the step of determining whether the request to apply originates from a customer that is logged in to a session manger, accessing stored data regarding the customer if the customer is logged in, and inserting the stored data in the application page. The steps of claim 4 permit the claimed system to use secure information regarding a customer to prefill fields in an application form for a product when information required to apply for the product is already known to the product provider. (Spec. p. 10, ll. 14-19.) In the final Office action in paragraph 9, it is acknowledged that Bowman-Amuah does not teach this step. It is asserted that Jawahar teaches this. Figures 3, 11, 13 and 14 are cited to support this assertion. Figure 3 of Jawahar illustrates a control server including a transaction host 102 and a transaction processing system 120. The transaction host 102 manages interaction between an agent and a customer. Jawahar col. 10, ll. 9-18. There is no suggestion that the transaction host or transaction processing system determines whether a customer is logged in or inserts stored data in an application page. Figures 11, 13, and 14 are flowcharts of the Jawahar system that illustrate that a session between a customer and an agent is established. There is no suggestion that this session includes determining whether a customer is logged in or inserting stored data in an application page. Jawahar shows that a user (first client) and agent (second client) can be connected though a joint session in which the server may duplicate what is presented to the user and the agent. Jawahar col. 8 ll. 26-40. In this manner the agent may view the resources viewed by the user and the agent may provide resources to the user. Jawahar col. 18, ll. 56-58. However, there is no suggestion that stored data regarding a customer is inserted in an application page for applying for products as set forth by claim 4. Furthermore, there is no suggestion to combine Bowman-Amuah and Jawahar for the reasons discussed above with respect to claim 1.

For at least the reasons set forth with respect to claim 1 and the further specific reasons set forth above, Bowman-Amuah in view of Jawahar does not show or suggest the steps of the

invention defined by dependent claim 4. Accordingly, the final Office action does not establish a *prima facie* case of obviousness against claim 4. Applicant respectfully requests that the rejection of claim 4 over Bowman-Amuah in view of Jawahar be reversed.

#### Claim 5

Claim 5 depends from claim 1 and therefore includes each step of the method of claim 1. Applicant respectfully submits that the applied references cannot properly be applied to demonstrate that the method set forth in claim 5 is obvious for at least the reasons set forth above with respect to independent claim 1. Further significant defects of the applied references as applied to claim 5 are discussed below.

Claim 5 sets forth that the plurality of products applied for includes banking products and the information required to apply for one of the products includes information regarding an amount of credit to be extended. Jawahar discusses uniform resource locator (URL) sharing as a method of providing user information to an agent. As an example of where URL sharing is *inappropriate*, Jawahar mentions banking transactions. Jawahar col. 19, ll. 27-46. Jawahar describes that in online banking transactions the customer's account number and transaction request information may be embedded in the URL. If the agent in this example were to access the same URL, the agent could improperly execute the banking transaction. Jawahar notes that online banking transactions may result in a withdrawal, transfer, or deposit. Significantly, Jawahar does not discuss applying for a bank account. In the transactions noted by Jawahar, the customer has already established an account with the banking services provider and has an account number. Accordingly, Jawahar includes no suggestion of any assembly of a page to apply for the bank account or other product. More specifically, there is no suggestion in Jawahar of an application page that contains a field corresponding to information regarding an amount of credit to be extended to the customer as specifically set forth in claim 5. There is also no motivation found in the prior art to combine the teaching of Jawahar with the teaching of Bowman-Amuah for the reasons discussed above with respect to claim 1. Jawahar teaches away from combining URL sharing with banking transaction systems.

For at least the reasons set forth with respect to claim 1 and the further specific reasons set forth above, Bowman-Amuah in view of Jawahar does not show or suggest the steps of the invention defined by dependent claim 5. Accordingly, the final Office action does not establish a



*prima facie* case of obviousness against claim 5. Applicant respectfully requests that the rejection of claim 5 over Bowman-Amuah in view of Jawahar be reversed.

#### Claim 6

Claim 6 depends from claim 5 and therefore includes each step of the method of claim 5. Applicant respectfully submits that the applied references cannot properly be applied to demonstrate that the method set forth in claim 6 is obvious for at least the reasons set forth above with respect to claims 1 and 5. Further significant defects of the applied references as applied to claim 6 are discussed below.

Claim 6 further sets forth forwarding the information input to a decision module for processing to determine if data input justifies extension of credit. The final Office action appears to rely on the same disclosure of Jawahar discussed above with respect to claim 5. As discussed above, Jawahar does not address the act of applying for any banking product. Jawahar merely uses an online transaction regarding an existing account as an illustrative example. Accordingly, Jawahar does not suggest any decision module that determines if extension of credit to a customer is justified. Furthermore, there is no motivation to combine Bowman-Amuah and Jawahar for the reasons discussed above with respect to claim 1.

For at least the reasons set forth with respect to claims 1 and 5 and the further specific reasons set forth above, Bowman-Amuah in view of Jawahar does not show or suggest the steps of the invention defined by dependent claim 6. Accordingly, the final Office action does not establish a *prima facie* case of obviousness against claim 6. Applicant respectfully requests that the rejection of claim 6 over Bowman-Amuah in view of Jawahar be reversed.

#### Claim 7

Claim 7 depends from claim 1 and therefore includes each step of the method of claim 1. Applicant respectfully submits that the applied references cannot properly be applied to demonstrate that the method set forth in claim 7 is obvious for at least the reasons set forth above with respect to independent claim 1. Further significant defects of the applied references as applied to claim 7 are discussed below.

Claim 7 sets forth that the request is in the form of parameters received within a universal resource locator. Jawahar is relied upon to show this limitation. (Final Office action ¶ 11.) The

Office action in paragraphs 6 and 11 cites to many parts of Jawahar that use an URL. Jawahar consistently shows the use of URLs and modified URLs for requesting information from a server, as is the function of a URL. However, Jawahar does not suggest any URL that is a request *to apply for products*, as is the request set forth in claim 1. Accordingly, there is no suggestion in the applied art of a request to apply for products in the form of a URL. Furthermore, there is no motivation found in the prior art to combine the teachings of Bowman-Amuah and Jawahar for the reasons discussed above with respect to claim 1.

For at least the reasons set forth with respect to claim 1 and the further specific reasons set forth above, Bowman-Amuah in view of Jawahar does not show or suggest the steps of the invention defined by dependent claim 7. Accordingly, the final Office action does not establish a *prima facie* case of obviousness against claim 7. Applicant respectfully requests that the rejection of claim 7 over Bowman-Amuah in view of Jawahar be reversed.

#### Claim 8

Claim 8 sets forth a system for obtaining application data from an applicant through a dynamically created application form. The claimed system includes a dynamic application module and a decision module. The dynamic application module receives requests to apply for at least one of a plurality of products, dynamically creates an application requesting data required to apply for the requested products, and receives the requested data. The decision module receives the data, generates a decision regarding the application, and provides the decision to the dynamic application module. Claim 8 is rejected on the same grounds as claim 1. The applied references do not show or suggest the system of claim 8 for reasons similar to those discussed above with respect to claim 1. Claim 8 is directed to a system for creating and processing applications for products, such as bank account or credit card accounts. Neither Bowman-Amuah nor Jawahar describe any system in which a consumer applies for any product such as a bank account or credit card. There is no suggestion to combine the teachings of Bowman-Amuah and Jawahar for the reasons discussed above with respect to claim 1.

In the final Office action, it is asserted that Jawahar teaches a decision module in communication with a dynamic application module. Figures 2 and 3 of Jawahar are relied upon to support this assertion. Figures 2 and 3 of Jawahar illustrate various servers, managers, and processing systems. However, none of these systems receive a request to apply for at least one

of a plurality of products, as does the dynamic application module set forth in claim 8. Nor do any of the systems in the applied art dynamically create an application that requests data required to apply for at least one of a plurality of products, as does the dynamic application module set forth in claim 8. Likewise, none of the systems disclosed in the applied art generate a decision regarding an application for at least one of a plurality of products, as does the decision module of claim 8. As discussed in detail above with respect to claim 1, the applied references simply do not suggest a system for receiving or processing any request to apply or any application for consumer products, such as banking products.

For at least the reasons set forth above, Bowman-Amuah in view of Jawahar does not show or suggest the components of the system defined by claim 8. Accordingly, the final Office action does not establish a *prima facie* case of obviousness against claim 8. Applicant respectfully requests that this rejection of claim 8 be reversed.

#### Claim 9

Claim 9 depends from claim 8 and therefore includes each step of the method of claim 8. Applicant respectfully submits that the applied references cannot properly be applied to demonstrate that the method set forth in claim 9 is obvious for at least the reasons set forth above with respect to independent claim 8. Further significant defects of the applied references as applied to claim 9 are discussed below.

Claim 9 further sets forth that the system includes a universal session manager and a profile database. The universal session manager verifies the originator of the request received by the dynamic application module. The profile database provides stored data regarding the originator of the request. Figure 2 and column 7, lines 53-65 of Jawahar are relied upon to show these features. Jawahar describes that an application server (shown in Figure 2) may retrieve information about a customer from a database (shown in Figure 2). Jawahar, col. 7 ll. 60-62. The information is then provided to an agent application for display on an agent computer system. Jawahar, col. 7 ll. 62-64. However, Jawahar includes no suggestion that the application server, or any other server, verifies the originator of a request, as does the universal session manager set forth in claim 9. Furthermore, there is no motivation to combine Bowman-Amuah and Jawahar for the reasons discussed above with respect to claim 1.

For at least the reasons set forth with respect to claim 1 and the further specific reasons set forth above, Bowman-Amuah in view of Jawahar does not show or suggest the steps of the invention defined by dependent claim 9. Accordingly, the final Office action does not establish a *prima facie* case of obviousness against claim 9. Applicant respectfully requests that the rejection of claim 9 over Bowman-Amuah in view of Jawahar be reversed.

### Claim 12

Claim 12 depends indirectly from claim 8 and therefore includes each step of the method of claim 8. Applicant respectfully submits that the applied references cannot properly be applied to demonstrate that the method set forth in claim 12 is obvious for at least the reasons set forth above with respect to independent claim 8. Further significant defects of the applied references as applied to claim 12 are discussed below.

Claim 12 further sets forth that the dynamic application module provides the application in the form of an application page over the network to the originator of the request. Figure 2 and column 8, lines 8-40 of Jawahar are relied upon to show this limitation. Jawahar describes a filter service that modifies web pages to coordinate and exchange information between the agent browser and the customer browser. Jawahar, col. 8 ll. 20-24. Thus, if the customer completes a form with the customer browser, the information entered may be communicated to the agent's browser. Jawahar, col. 8 ll. 25-28. However, there is no suggestion in Jawahar that the form itself is dynamically created based on a customer request. There is also no suggestion that the form is an application form requesting data to apply for products. Jawahar, therefore, does not show or suggest dynamically creating an application page requesting data required to apply for at least one of a plurality of products and providing the application page to one who requested to apply for the products. As the dynamic application module set forth by claim 12 is for creating such an application page, Jawahar cannot show or suggest the dynamic application module as set forth by claim 12. Furthermore, there is no suggestion to combine Bowman-Amuah and Jawahar for the reasons discussed above with respect to claim 1.

For at least the reasons set forth with respect to claim 8 and the further specific reasons set forth above, Bowman-Amuah in view of Jawahar does not show or suggest the steps of the invention defined by dependent claim 12. Accordingly, the final Office action does not establish

a *prima facie* case of obviousness against claim 12. Applicant respectfully requests that the rejection of claim 12 over Bowman-Amuah in view of Jawahar be reversed.

#### Claim 14

Claim 14 defines a method for dynamically creating an application form in a manner similar to claim 1. Claim 14 further sets forth that the request to apply for at least one of a plurality of products is in the form of a uniform resource locator, similar to the limitation of claim 7. Claim 14 includes the step of parsing the uniform resource locator to identify the products. Claim 14 also includes all the steps and limitations discussed above with respect to claim 1. Claim 14 is rejected for the same reasons as claim 1. Accordingly, Bowman-Amuah in view of Jawahar does not show the method of claim 14 for at least the reasons discussed above with respect to claims 1 and 7. Applicants respectfully request the reversal of the rejection of claim 14 over Bowman-Amuah in view of Jawahar as these references fail to render claim 14 obvious for the same reasons as discussed above with respect to claims 1 and 7.

#### Claims 15-19 dependent from Claim 14

Claims 15-19 are identical to claims 2-6 but for depending from claim 14. Claims 15-19 are rejected for the same reasons as claims 2-6. Bowman-Amuah in view of Jawahar does not show or suggest the invention as defined by claims 15-19 for the same reasons as discussed above with respect to claim 14 and claims 2-6. Applicant respectfully request that the rejections of claims 15-19 be reversed for the reason set forth above.

Conclusion

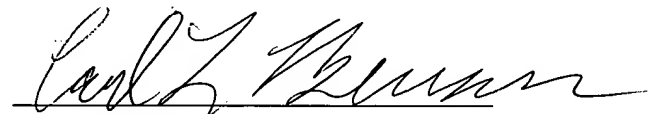
The claimed invention relates to the dynamic creation of an application form, that is a form for submitting information to apply for products and services. The applied prior art is silent regarding the creation of an application form. Accordingly, the applied prior art cannot suggest the invention set forth by the pending claims. Applicant has replied to every rejection set forth in the final Office action in the above remarks. Each rejection has been shown deficient or overcome for the reasons set forth above. Accordingly, applicant submits that pending claims 1-19 are patentably distinguishable over the prior art of record. Applicant requests that the rejections be reversed, the application be returned to the Examiner and the claims allowed.

Respectfully submitted,

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## Appendix

### Claims Involved in Appeal

1. A method for dynamically creating a network based application form comprising the steps of:

receiving a request to apply for a plurality of products, the request received over a network, wherein specific information is required to be submitted to apply for each one of the plurality of products;

assembling an application page for display over the network, said page assembled from a plurality of documents, wherein each document of the plurality of documents contains at least one field corresponding to the specific information required to apply for one of the plurality of products; and

receiving information input corresponding to each field contained in the application page.

2. The method of claim 1, further including the steps of:

validating the information input by comparing the information input to validation criteria; and

when the information input fails to correctly compare to the validation criteria, assembling a second application page including prompts to reenter information and receiving corrected information input.

3. The method of claim 1, further including the step of forwarding the information input to a decision module for processing the information input.

4. The method of claim 1, further including the steps of:

determining whether the request to apply originates from a customer that is logged in to a session manager;



accessing stored data regarding the customer if the customer is logged in, wherein the step of assembling an application page includes inserting the stored data in the application page displayed over the network.

5. The method of claim 1 wherein the plurality of products includes banking products and the specific information required to apply for one of the plurality of products includes information regarding an amount of credit to be extended.

6. The method of claim 5 further including the step of forwarding the information input to a decision module for processing the information input to determine if data input justifies extension of credit.

7. The method of claim 1 wherein the request is in the form of parameters received within a universal resource locator.

8. A system for obtaining application data from an applicant through a dynamically created network based application form comprising:

a dynamic application module for receiving a request to apply for at least one of a plurality of products, dynamically creating an application requesting data required to apply for the at least one a plurality of products, and receiving the data requested; and

a decision module in communication with said dynamic application module, said decision module for receiving the data, generating a decision regarding the application, and providing the decision to said dynamic application module.

9. The system according to claim 8 further comprising:

a universal session manager in communication with said dynamic application module, said universal session manager for creating a verification of an originator of the request; and

a profile database in communication with said dynamic application module, said profile database for providing stored data regarding the originator of the request.

10. The system according to claim 9 further comprising a host server wherein said dynamic application module, said universal session manager and said database reside on said host server.

11. The system according to claim 10 wherein said host server is connected to a network.

12. The system according to claim 11 wherein said dynamic application module provides the application in the form of an application page over the network to the originator of the request.

13. The system according to claim 8 further including a processing database in communication with said dynamic application module, said processing database for receiving data regarding use of said dynamic application module.

14. A method for dynamically creating a network based application form comprising the steps of:

receiving, over a network, a request to apply for at least one of a plurality of products in the form of a uniform resource locator, wherein specific information is required to be submitted to apply for each one of the plurality of products;

parsing the uniform resource locator to identify the at least one of a plurality of products;

assembling an application page for display over the network, said page assembled from a plurality of documents, wherein each document of the plurality of

documents contains at least one field corresponding to the specific information required to apply for one of the plurality of products; and

receiving information input corresponding to each field contained in the application page.

15. The method of claim 14, further including the steps of:

validating the information input by comparing the information input to validation criteria; and

when the information input fails to correctly compare to the validation criteria, assembling a second application page including prompts to reenter information and receiving corrected information input.

16. The method of claim 14, further including the step of forwarding the information input to a decision module for processing the information input.

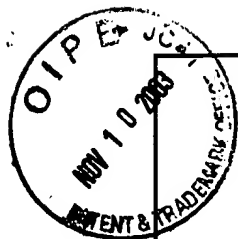
17. The method of claim 14, further including the steps of:

determining whether the request to apply originates from a customer that is logged in to a session manager;

accessing stored data regarding the customer if the customer is logged in, wherein the step of assembling an application page includes inserting the stored data in the application page displayed over the network.

18. The method of claim 14 wherein the plurality of products includes banking products and the specific information required to apply for one of the plurality of products includes information regarding an amount of credit to be extended.

19. The method of claim 18 further including the step of forwarding the information input to a decision module for processing the information input to determine if data input justifies extension of credit.



AF 3624 \$

## FEE TRANSMITTAL

MAIL STOP

## APPEAL BRIEF-PATENTS

Complete If Known

Application No.	09/599,602
Filing Date	June 23, 2000
First Named Inventor	Robert J. ROSKO
Examiner Name	Geoffrey R. AKERS
Art Unit	3624

Total Amount Of Payment (\$)**330**

Attorney Docket No. 47003.000073

## METHOD OF PAYMENT (check one)

## FEE CALCULATION (continued)

1. ☒ The Commissioner for Patents is hereby authorized to charge indicated fees and credit any over payments to **Deposit Account No. 50-0206** in the name of Hunton & Williams LLP.

## 3. ADDITIONAL FEES

Fee Description	Fee Paid
<input type="checkbox"/> Surcharge - late filing fee or oath	\$
<input type="checkbox"/> Surcharge - late provisional filing fee or cover sheet	\$
<input type="checkbox"/> _____ Month Extension of Time	\$
<input type="checkbox"/> Notice of Appeal	\$
<input checked="" type="checkbox"/> Filing Brief in Support of Appeal	\$ <b>330</b>
<input type="checkbox"/> Request for Oral Hearing	\$
<input type="checkbox"/> Utility Issue Fee (or Reissue) (including Publication Fee, if necessary)	\$
<input type="checkbox"/> Design Issue Fee	\$
<input type="checkbox"/> Plant Issue Fee	\$
<input type="checkbox"/> Petition to Commissioner	\$
<input type="checkbox"/> Petition to Revive (Unavoidable)	\$
<input type="checkbox"/> Petition to Revive (Unintentional)	\$
<input type="checkbox"/> Petitions Related to Provisional Applications	\$
<input type="checkbox"/> Submission of Information Disclosure Statement	\$
<input type="checkbox"/> Filing Submission After Final Rejection	\$
<input type="checkbox"/> Recording Each Patent Assignment Per Property	\$
<input type="checkbox"/> Filing Request for Reexamination	\$
<input type="checkbox"/> Other (specify) _____	\$

2. ☒ Check Enclosed. The Commissioner for Patents is hereby authorized to charge any variance between the amount enclosed and the Patent Office charges to **Deposit Account No. 50-0206** in the name of Hunton & Williams LLP, 1900 K Street, N.W., Suite 1200, Washington, D.C. 20006-1109.

## FEE CALCULATION

1. BASIC FILING FEE ☒ Large Entity ☐ Small Entity

## FEE PAID

Utility Filing Fee	\$
Design Filing Fee	\$
Plant Filing Fee	\$
Reissue Filing Fee	\$
Provisional Filing Fee	\$

## 2. EXTRA CLAIMS FEES

## CLAIMS AS AMENDED

For	Number Present	Highest Number Paid For	Extra	Rate		Amount
				Large Entity	Small Entity	
TOTAL CLAIMS		1	0	x \$ 18.00	x \$ 9.00	\$ 0.00
INDEPENDENT CLAIMS		0	0	x \$ 86.00	x \$ 43.00	\$ 0.00
MULTIPLE DEPENDENT CLAIMS				\$ 290.00	\$ 145.00	\$ 0.00
TOTAL EXTRA CLAIMS FEES						\$ 0.00

SUBMITTED BY

Complete (if applicable)

Typed or Printed Name Carl L. Benson

Registration No. 38,378

Signature

Date

November 10, 2003

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